

REMARKS

The claims in the application are now claims 1-8 and 10-18, the withdrawn claim 9 having been replaced by new claim 17 (claims 17 and 10-12 are directed to presently withdrawn subject matter, but should be rejoined). **The claims define patentable subject matter for reasons pointed out in the Reply filed April 6, 2009, the remarks of which are respectfully repeated by reference.** Applicants again respectfully request favorable reconsideration and allowance.

In addition to the withdrawn main claim 17, the other main claims are now claims 1, 15 and 18. The helpful suggestion of the examiner appearing in the last sentence of the top paragraph on page 3 of the Advisory Action of April 16, 2009, has been adopted. The amendments made in the claims are essentially cosmetic and do not add limitations to the claims.

That the uncoated ultrafine chalk (page 8, line 2 of applicants' specification) is precipitated calcium carbonate appears in applicants' specification at page 8, lines 2-4 and lines 12-14.

The amendments to claim 8 are also cosmetic, i.e. without any change in scope, reference being made to the

paragraph following Table 1 at page 9 of applicants' specification extending through the top of page 10.

The rejections appearing in the Final rejection of January 6, 2009 are addressed in the remarks of the Reply filed April 6, 2009, and are respectfully repeated by reference.

The Advisory Action of April 16, 2009, states that applicants' arguments with respect to the rejections based on 35 USC 112 "are not persuasive." Accordingly, applicants further address these rejections below.

Applicants of course respectfully disagree with and traverse the rejections based on Section 112 for the reasons previously submitted and hereby respectfully repeated (as indicated above).

The Advisory Action states, "The specification is directed toward mineral fillers and states that ultrafine chalk is the preferred mineral filler (page 7, lines 7-8). Since it is only a preferred filler means that the composition is open to other mineral fillers. Also, since ultrafine chalk is a preferred filler it can be included in the composition along with the uncoated ultrafine chalk." [Emphasis added] Thus, the PTO does not dispute and cannot dispute that applicants' specification presents different options, namely

the option of other mineral fillers, the option of the ultrafine chalk (the same as uncoated ultrafine chalk) being present with another filler, and the option of uncoated ultrafine chalk being used by itself. Indeed it is this last option which is the one which is recited in original claim 1, in the Abstract, and in Examples 1 and 2 (e.g. see Table 1 on page 9 of applicants' specification).

What the PTO is apparently trying to do is deny the applicants the right and ability to claim **less than** what is most broadly set forth in their specification, i.e. claiming a species or sub-genus from among the alternatives clearly presented in the specification. This the PTO may not properly do.

In this regard, attention is respectfully invited to *In re Saunders et al*, 170 USPQ 213, 219-20 (CCPA 1971). This is a case in which the applicants retreated to their "preferred surfactants." The solicitor argued that the specification "does not indicate that the choice of these particular surfactants, as opposed to others appellants disclosed and formerly claimed is 'critically significant.'" The appellants argued to the contrary that they had a perfect right to claim less than they originally claimed.

The court agreed with the appellants. "Since the patent law provides for the amendment during prosecution of

claims, as well as the specification supporting claims,... it is clear that the reference to 'particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention'...does not prohibit the applicant from claiming what he 'regards as his invention' (i.e., the subject matter on which he seeks patent protection) during the pendency of his application."

Certainly, it is very common for an applicant to claim less than what he started out as claiming. It is extremely common, indeed usual, for an applicant during prosecution of his application to cut down on the scope of what he is claiming. Thus, fact that applicants' specification in the present case permits options other than that presently claimed, does not inhibit applicants from claiming only one of the options, namely the option wherein the mineral filler is the single and only mineral filler which is preferred and is set forth in Examples 1 and 2.

If any other case law were needed to support applicants' position, applicant would refer to *Reeves Brothers, Inc. v. U.S. Laminating*, 157 USPQ 235, 245 (1968), where the court indicated that an applicant may delete from his specification certain items mentioned as equivalents to others since this is a limiting amendment adding nothing new.

Indeed, an applicant may limit his claims even to an embodiment which is not preferred or critical, noting *In re Luvisi et al*, 144 USPQ 646, 651 (CCPA 1965), where Judge Rich, speaking for the court, stated as follows:

We see no reason for requiring a showing of "criticality," whatever may have been intended by that term, of a limitation which finds support in the original disclosure which is added to the claims for purposes of advancing prosecution of the application, and which is never alleged by the applicants to be "critical". If an applicant under these circumstances narrows the scope of his claims, he should be entitled to do so without being required to prove criticality.

There is no doubt that the use of the uncoated ultrafine chalk as the sole mineral filler is an option provided in applicants' specification. Therefore, applicants have a perfect right to claims which exclude the presence of other mineral fillers.

Withdrawal of the rejections and allowance are respectfully requested.

Applicants believe that all outstanding issues are addressed above in a manner that should lead to patentability

of the present application. Favorable reconsideration and allowance are respectfully requested.

Respectfully submitted,

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